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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,890	09/29/2003	Yasuhiro Abe	848075-0058	1991
29619 7590 02/18/2010 SCHULTE ROTH & ZABEL LLP ATTN: JOEL E. LUTZKER 919 THIRD AVENUE NEW YORK, NY 10022				
EXAMINER NGUYEN, KHAI MINH				
ART UNIT 2617		PAPER NUMBER		
MAIL DATE 02/18/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/673,890

Applicant(s)

ABE, YASUHIRO

Examiner

KHAI M. NGUYEN

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-12, and 14 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-3 and 5-14 have been considered but are moot in view of the new ground(s) of rejection.

Iijima teaches a screen on said display unit is able to display a first selection screen (fig.3c) which displays items and allows a selection to be made using said auxiliary input unit ([0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick), and which is appropriate for an operation by said auxiliary input unit (scrolling key 8, [0022]-[0023]) when both of said housings are in said closed state screen (fig.3c, [0034]), and a screen on said display unit is able to display a second selection screen (see fig.4a, [0028] covering device 5 is opened) which is different from said first selection screen (fig.3c (covering device 5 closed), [0028] and [0036]-[0037]), and which is appropriate for an operation by said main input unit (key stroke section 2) when both of said housings are in said opened state ([0017] menu screen of mode selection display of a display, [0028]-[0038]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiumi Hideo (JP-2001-313701) in view of Lijima Takahiro (JP-2001-298513).

Regarding claim 1, Kiumi Hideo teaches a portable terminal (fig.1) comprising:

a first housing having a display unit (fig.1 and 5 1st case, LCD 22 and 32);

a second housing having a main input unit (fig.1 and 5, 2nd case, key group 33), and connected openably (fig.1 and 6, hinge region 11) and closably to said first housing (fig.1 and 5, hinge region 11, [0047]); and

an auxiliary input unit arranged on a surface other than mutually facing surfaces of both of said housings in a closed state (fig.5b, 3D jog dial, [0043]-[0044]);

wherein said display unit (fig.1 and 5, LCD 32 and 22) is visible to a user in said closed state (LCD 32) and an opened state (LCD 22) (fig.1 and 5, [0043]-[0044]),

the portable terminal further comprising:

a state detecting device (fig.6, detection switch 53 and 51) which detects opening and closing of both said housings ([0061]-[0063]);

a control device (3D jog dial (control unit) 26), which switches a display screen on said display unit ([0019]-[0020]);

wherein said control device switches (item 51) between said first selection screen (LCD 32) and said second selection screen (LCD 22) in accordance with a state detected by said state detecting device (solution, [0024]-[0027]).

Kiumi Hideo fails to specifically disclose a screen on said display unit is able to display a first selection screen which displays items and allows a selection to be made using said auxiliary input unit, and which is appropriate for an operation by said auxiliary input unit when both of said housings are in said closed state, and a screen on said display unit is able to display a second selection screen which is different from said first selection screen, and which is appropriate for an operation by said main input unit when both of said housings are in said opened state.

However, Iijima teaches a screen on said display unit is able to display a first selection screen (fig.3c) which displays items and allows a selection to be made using said auxiliary input unit ([0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick), and which is appropriate for an operation by said auxiliary input unit (scrolling key 8, [0022]-[0023]) when both of said housings are in said closed state screen (fig.3c, [0034]), and a screen on said display unit is able to display a second selection screen (see fig.4a, [0028] covering device 5 is opened) which is different from said first selection screen (fig.3c, [0028] and [0036]-[0037]), and which is appropriate for an operation by said main input unit (key stroke section 2) when both of said housings are in said opened state ([0017] menu screen of mode selection display of a display, [0028]-[0038]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of Iijima to Kiumi Hideo to provide the scrolling key which enables scrolling of a screen in a one direction or the direction of plurality.

Regarding claim 2, Lijima further teaches first selection screen arranges items one-dimensionally ([0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick), and said second selection screen arranges items multi-dimensionally ([0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick)

Regarding claim 3, Lijima further teaches items of said first selection screen are based on characters ([0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick, [0029]-[0038]), and said items of said second selection screen are icons ([0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick, [0029]-[0038]).

Regarding claim 5, Lijima further teaches items on said first selection screen are based on characters ([0029]-[0038]), items on said second selection screen are based on icons ([0029]-[0038]), and when a selection screen has been switched in response to an opening action or a closing action from a state in which an item on said first or said second selection screen has been selected ([0029]-[0038]), said item remains selected in a form of a character or an icon corresponding to said first or said second selection screen ([0029]-[0038]).

Regarding claim 6, Kiumi Hideo and Iijima further teach main input unit (key group 33) includes a key capable of being two-dimensionally operated (see Kiumi Hideo, 3D jog dial 26), and said auxiliary input unit (see Kiumi Hideo, 3D jog dial 26)

includes a lever capable of being one-dimensionally operated (see Lijima, [0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick).

Regarding claim 7, Kiumi Hideo teaches portable terminal is a personal digital assistant ([0001]).

Regarding claim 8, Kiumi Hideo teaches portable terminal is a portable telephone ([0001]).

Regarding claim 9, Kiumi Hideo teaches a portable terminal comprising:

a first housing having at least a display unit (fig.1 and 5 1st case, LCD 22 and 32);

a second housing having at least a main input unit (fig.1 and 5, 2nd case, key group 33), and connected openably and closably to said first housing (fig.1 and 5, hinge region 11, [0047]); and

an auxiliary input unit (fig.5b, 3D jog dial 26) arranged on a surface other than mutually facing surfaces of both of said housings in a closed state (fig.5b); wherein said display unit (fig.5b, LCD 32) is visible to a user in said closed state (fig.5b, paragraph 0043-0045) and an opened state (fig.5a, LCD 22, [0043]-[0045]),

the portable terminal further comprising:

a state detecting device (fig.6, detection switch 53 and 51) which detects opening and closing of both said housings ([0061]-[0063]);

a control device (3D jog dial (control unit) 26), which switches a display screen on said display unit ([0019]-[0020]);

wherein said control device switches (item 51) between said first selection screen (LCD 32) and said second selection screen (LCD 22) in accordance with a state detected by said state detecting device (solution, [0024]-[0027]).

Kiumi Hideo fails to specifically disclose a screen on said display unit is able to display a first selection screen which is appropriate for an operation by said auxiliary input unit when both of said housings are in said closed state, and a screen on said display unit is able to display a second selection screen which is appropriate for an operation by said main input unit when both of said housings are in said opened state.

However, Lijima teaches a screen on said display unit is able to display a first selection screen (fig.3c) which is appropriate for an operation by said auxiliary input unit (see fig.3c, [0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick, [0034]), and a screen on said display unit (fig.4a-c) is able to display a second selection screen (see fig.4a, [0028] covering device 5 is opened) which is appropriate for an operation by said main input unit (key stroke section 2) when both of said housings are in said opened state ([0017] menu screen of mode selection display of a display, [0028]-[0038]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of Lijima to Kiumi Hideo to provide the scrolling key which enables scrolling of a screen in a one direction or the direction of plurality.

Regarding claim 10, Kiumi Hideo and Lijima further teach a portable terminal according to claim 9, wherein said main input unit (see Kiumi Hideo, fig.1 and 5, key group 33, [0049]) includes a key capable of being two-dimensionally operated (see Kiumi Hideo, [0016]), and said auxiliary input unit (see Kiumi Hideo, 3D jog dial 26) includes a lever capable of being one-dimensionally operated ([0017]-[0020]), and wherein said items on said first selection screen can be selected by said lever operation (see Iijima, [0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick), and said items on said second selection screen can be selected by said key operation (see Lijima, [0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick, [0029]-[0038]).

Regarding claim 11, Kiumi Hideo teaches portable terminal is a personal digital assistant ([0001]).

Regarding claim 12, Kiumi Hideo teaches portable terminal is a portable telephone ([0001]).

Regarding claim 14, Lijima teaches main input unit includes a key capable of being operated in a direction of an arrangement of said items on said second screen (fig.4a-c, [0017], [0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick, [0029]-[0038]), and said auxiliary input unit includes a lever capable of being operated in a direction of an arrangement of said items on said first selection screen (fig.4a-c, [0017], [0022]-[0023] the scrolling key 8 is like a trackball, a trackpad, a floating switch, and a joy stick, [0029]-[0038]).

Allowable Subject Matter

4. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: when said housings are in said opened state, said control device locks said auxiliary input unit so that operations of said auxiliary input unit are invalid.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAI M. NGUYEN whose telephone number is (571)272-7923. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on 571.272.7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617

/Khai M Nguyen/
Examiner, Art Unit 2617

2/10/2010